

Attorney Docket No.: PENN-0857
Inventors: Eberwine and Madison
Serial No.: 10/630,333
Filing Date: July 30, 2003
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REMARKS

Claims 1 and 2 are pending in the instant application. Claims 1 and 2 have been rejected. Claims 1 and 2 have been amended. Support for these amendments is provided in the specification at pages 3-5. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Nonstatutory Double Patenting Rejection

Claims 1-2 have been rejected on the ground of nonstatutory double patenting as being unpatentable over claim 1 of U.S. Patent 6,623,965, issued September 23, 2003. The Examiner has acknowledged that the conflicting claims are not identical. However, the Examiner suggests that the claims 1-2 are drawn to an improved method of directional cloning of DNA and the method steps are in steps (e)-(g) of claim 1 of U.S. Patent 6,623,965.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants are submitting herewith a terminal disclaimer with respect to U.S. Patent 6,623,965.

Withdrawal of this nonstatutory double patenting rejection is therefore respectfully requested.

II. Rejection of Claim 1-2 under 35 U.S.C. 112, second paragraph

Claims 1-2 have been rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to

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particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner suggests that there are not enough active steps to understand the claimed method.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to include additional active steps. Support for these amendments is provided in the specification at pages 3 through 5 and in Figure 2a-c. Claim 2 has been amended to include reference to steps of claim 1. No new matter is added by these amendments.

Withdrawal of this rejection under 35 U.S.C. 112, second paragraph is respectfully requested in light of these amendments.

III. Rejection of Claims 1-2 under 35 U.S.C. 102(e)

Claims 1-2 have been rejected under 35 U.S.C. 102(e) as being anticipated by Fry et al. (U.S. Patent 6,114,149) issued September 5, 2000. The Examiner suggests that since the method of Fry et al. involves applying two oligonucleotide sequences which have a restriction site at the 5' end of the sequence and a homopolymeric tail at the 3' end of the sequence to form a single stranded DNA circle in the presence of restriction enzyme, DNA polymerase and ligase, and the instant claims do not explicitly present how the stable replication competent gapped single stranded

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circle is formed with two oligonucleotides encoding a restriction site at the 5' end and comprising a homopolymeric tail at the 3' end in the presence of restriction enzyme, DNA polymerase and ligase, the teachings of Fry et al. anticipate claims 1 and 2.

As discussed in Section II, supra, the claims have been amended to include additional action steps. In particular, claim 1 has been amended to include step (c) wherein single-stranded (-) cDNAs with double-stranded regions of step (b) are cleaved with a cognate restriction enzyme so that regions to be replicated in a second (+) strand synthesis are limited. Fry, et al. do not teach cleavage of double-stranded regions on the single-stranded (-) cDNAs, created by annealed primers, so that regions to be replicated in a second (+) strand synthesis are limited.

MPEP 2131 is clear; to anticipate a claim, the reference must teach every element of the claim. Since Fry et al. do not teach every element of the instant claims, this reference cannot anticipate the claimed invention.

Withdrawal of this rejection under 35 U.S.C. 102(e) is therefore respectfully requested.

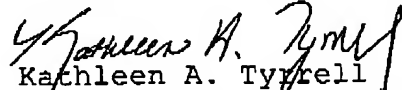
IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

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Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


Kathleen A. Tyrrell
Registration No. 38,350

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Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515